

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

MARTIN GROHMAN

Serial No.: 10/634,499

Filed: August 5, 2003

HIDDEN DECK FASTENER SYSTEM

Docket No.: 33105

Confirmation No.: 8662

Group Art Unit No.: 3635

Customer No.: 23589

Examiner: Naoko N. Slack

Assistant Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

STATEMENT

In accordance with Applicants' duty of candor toward the Office, Applicants previously advised the Examiner of the existence of U.S. Patent Application 10/634,497, filed August 5, 2003, entitled GROOVED DECKING BOARD. An office action was mailed in the '497 application on October 6, 2006, in which several claims were rejected as being anticipated by, or obvious in view of one or more references. A copy of that action is enclosed.

Respectfully submitted,

By



Tracy L. Bornman, Reg. No. 42,347
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, MO 64108
(816) 474-9050

ATTORNEYS FOR APPLICANT(S)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,497	08/05/2003	Martin Grohman	34192	8665

7590
Hovey Williams LLP
Suite 400
2405 Grand Blvd.
Kansas City, MO 64108

10/06/2006

EXAMINER
CANFIELD, ROBERT
ART UNIT
PAPER NUMBER

3635

DATE MAILED: 10/06/2006

RECEIVED

OCT 10 2006

HOVEY WILLIAMS LLP

Please find below and/or attached an Office communication concerning this application or proceeding.

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OCT 10 2006

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Office Action Summary

Application No.	Applicant(s)	
10/634,497	GROHMAN, MARTIN	
Examiner	Art Unit	
Robert J. Canfield	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTER STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received In Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/21/06 has been entered. Claims 1-4 and 6-20 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 7, 10, 11 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,394,667 to Nystrom.

See figure 12. As to claim 11 elements 40 are considered the joists. As to claims 10 and 16, the process in which an article is produced need not be met in an article claims as long as all of the claimed structure is provided in the prior art.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 6, 8-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,394,667 to Nystrom.

Nystrom provides each of the elements of these claim in figure 12 except for specifying the dimensional limitation and that the board 50 is made from a composite material of cellulosic fibers and plastic.

The examiner takes Official Notice that making boards of conventional lumber type dimensions from a composite material of cellulosic fibers and plastic is well known and that it would have been obvious at the time of the invention to one having ordinary skill in the art that the boards of Nystrom could have been out of such material. It would have been obvious to make the boards out of a composite for environmental reason and because such boards are less susceptible to decay and rot.

Each of the recited dimensional limitations claimed are viewed as choices of design which would have been obvious at time of the invention to one having ordinary skill in the art particularly in view of the fact both the instant invention and Nystrom relate to decking boards and Nystrom recites that the features of his invention are applied to conventionally dimension lumber products which have a thickness which falls within the 0.5 to 2 inches. Figure 12 would suggest that the upper lip extends at least about 20% further than the lower lip and a slight spacing would be desirable to allow for water to run off and thus not accumulate upon the surface of the deck.

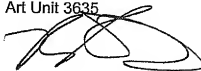
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
Art Unit 3635



09/29/06

Notice of References Cited

Application/Control No.

10/634,497

Applicant(s)/Patent Under
Reexamination
GROHMAN, MARTIN

Examiner

Robert J. Canfield

Art Unit

3635

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-5,623,803	04-1997	Willis, Mark C.	52/650.3
*	B	US-5,887,331	03-1999	Little, David L.	29/509
*	C	US-5,928,735	07-1999	Padmanabhan et al.	428/33
*	D	US-6,453,630	09-2002	Buhrts et al.	52/177
*	E	US-6,586,504	07-2003	Archuletta et al.	524/16
*	F	US-6,394,667	03-1995	Nystrom, Ron	52/480
*	G	US-5,850,720	12-1998	Willis, Mark C.	52/650.3
*	H	US-D485,373	01-2004	Morton et al.	D25/125
*	I	US-1,714,738	05-1929	SMITH ARTHUR R	52/512
*	J	US-4,409,906	10-1983	Alneng, Carl-Goran	514/356
*	K	US-6,470,641	10-2002	Faure, Didier	52/480
*	L	US-6,694,691	02-2004	Ku, Chen Chung	52/403.1
*	M	US-6,871,467	03-2005	Hafner, Robert	52/588.1

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Notice of References Cited

Application/Control No.

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GROHMAN, MARTIN

Examiner

Robert J. Canfield

Art Unit

3635

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2002/0121064	09-2002	Erwin, Ronald D.	52/586.1
*	B	US-186,463	01-1877	Dickinson	52/512
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
✓	N	2 418 569	08-2006	Canada	Eberle	E04B 5/00
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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